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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/775,818	02/05/2001	Kaname Ishibashi	400684	5334
23548	7590	06/16/2003		
LEYDIG VOIT & MAYER, LTD 700 THIRTEENTH ST. NW SUITE 300 WASHINGTON, DC 20005-3960			EXAMINER [REDACTED]	WHISENANT, ETHAN C
			ART UNIT [REDACTED]	PAPER NUMBER 1634
DATE MAILED: 06/16/2003				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/775,818	ISHIBASHI ET AL.
	Examiner Ethan Whisenant, Ph.D.	Art Unit 1634

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on 26 March 2003.

2a) This action is FINAL.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) Claim(s) 11-18 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) 13 and 14 is/are allowed.

6) Claim(s) 11,12 and 15-18 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____.
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.	6) <input type="checkbox"/> Other: _____.

## FINAL REJECTION

1. The applicant's Response (filed 26 MAR 03) to the Office Action has been entered. Following the entry of the claim amendment(s), **Claim(s) 11-18** is/are pending. Rejections and/or objections not reiterated from the previous office action are hereby withdrawn. The following rejections and/or objections are either newly applied or reiterated. They constitute the complete set presently being applied to the instant application.

### CLAIM OBJECTIONS

2. **Claim(s) 18** is/are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Note that Claim 18 is dependent on a canceled Claim (i.e. Claim 1).

### 35 USC § 112- 2ND PARAGRAPH

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

### CLAIM REJECTIONS under 35 USC § 112- 2ND PARAGRAPH

4. **Claim(s) 11-12, 15-18** is/are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

**Claim 11** is indefinite because the phrase "said mRNA" on lines 8-9 lacks proper antecedent basis. It unclear to which mRNA thisd refers. Does ity refer to the expressed mRNA on line 1 or to the specific mRNA on line 7.

**35 USC § 102**

**5.** The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that may form the basis for rejections set forth in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) The invention was described in --

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or  
(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a)

**Claim Rejections under 35 USC § 102**

**6.** **Claim(s) 11-12 and 15** is/are rejected under 35 U.S.C. 102(b) as being anticipated by Singer et al. [US Patent No. 5,728,527 (1998)].

Singer et al. teach all of the limitations of Claim 11-12 and 15. As regards the limitation in the first step of Claim 11 wherein "a site of the mRNA is determined to have high accessibility for oligo probe hybridization", it is the examiner's position that Singer et al. teach determining that mRNA has a high accessibility for oligo probe hybridization, by experimentation. See, for example, at least, Column 11, lines 1-20. Admittedly, Singer et al. do not explicitly teach the detection of a particular specific mRNA target, however, these authors do teach that "cells or tissues can be characterized for the presence of the expression of specific RNA or DNA sequences." Please note that Claim 11, as presented, does not require the detection of a specific mRNA only that the "live cells express a specific mRNA." As all living cells express mRNA (i.e. specific mRNA), it is asserted that Singer et al. teach all of the limitations of Claims 11-12 and 15.

**35 USC § 103**

**7.** The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**8.** This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. § 103, the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligations under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of potential 35 U.S.C. § 102(f) or (g) prior art under 35 U.S.C. § 103.

**CLAIM REJECTIONS UNDER 35 USC § 103**

**9.** **Claim(s) 16-18** is/are rejected under 35 U.S.C. 103(a) as being unpatentable over Singer et al. [US Patent No. 5,728,527 (1998)] as applied against Claim 11 above and further in view of Levinson et al. (2003).

Singer et al. teach all of the limitations of Claims 16-18 except these authors do not explicitly teach an embodiment wherein the target mRNA is a cytokine. Neither do these authors teach that the cells separated are TH1 cells or TH2 cells. However, Levinson et al. teach the identification, separation and isolation of TH1 or TH2 cells based on the differential expression of certain proteins including cytokines. See for example Column 3, at beginning at about line 61. Therefore, absent an unexpected result it would have been *prima facie* obvious to one of ordinary skill in the art at the time of the invention to modify the method of Singer et al. wherein mRNA for cytokines and/or other proteins differentially expressed in TH cell subpopulations is used to isolate a TH cell subpopulation of interest (i.e. TH1 or TH2 cells). The motivation to make this modification comes from Levinson, see, for example Column 3, at beginning at about line 61 wherein they teach "A primary goal, for both diagnostic and therapeutic reasons, therefore, would be the ability to identify, isolate and/or target members of a particular TH cell subpopulation. The ability to identify those genes which are differentially expressed

within and/or among such TH cell subpopulations is required to achieve such a goal. To date, investigations have focused on the expression of a limited number of specific known cytokines and cytokine receptors in the TH cell population. Cytokines, however, exert effects on cell types in addition to specific TH cell subpopulations, i.e., exhibit a variety of pleiotropic effects. It would be beneficial, therefore, to identify reliable markers (e.g., gene sequences) of TH cell subpopulations whose effects are TH cell subpopulation specific, e.g., which, unlike secreted cytokines, are TH cell subpopulation specific." Furthermore, note that Singer et al. teach in Column 2, beginning at about line 1 - line 16 that their procedure "permits the selection of cells or subpopulations of cells based on gene expression or the presence of a target sequence. After hybridization, the cells of interest can be evaluated with respect to other parameters and segregated by methods such as microdissection or flow sorting. The selected cells can be cultured, further characterized or used as a source of RNA for the construction of cDNA libraries.

#### **ALLOWABLE SUBJECT MATTER**

**10.** **Claims 13-14** is/are allowable over the prior art of record at least because the prior art of record does not teach or reasonably suggest probes having the base sequence set forth in SEQ ID NO: 9, SEQ ID NO: 10, SEQ ID NO: 17, or SEQ ID NO: 18.

#### **RESPONSE TO APPLICANT'S AMENDMENT/ ARGUMENTS**

**11.** Applicant's arguments with respect to the claimed invention have been fully and carefully considered but are moot in view of the new ground(s) of rejection.

#### **CONCLUSION**

**12.** **Claim(s) 13-14** is/are allowable while **Claim(s) 11-12 and 15-18** is/are rejected and/or objected to for the reason(s) set forth above.

**13.** Applicant's amendment necessitated the new grounds of rejection. Accordingly, **THIS ACTION IS MADE FINAL**. See M.P.E.P. § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

**14.** Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ethan Whisenant, Ph.D. whose telephone number is (703) 308-6567. The examiner can normally be reached Monday-Friday from 8:30AM -5:30PM EST or any time via voice mail. If repeated attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, W. Gary Jones, can be reached at (703) 308-1152.

The fax number for this Examiner is (703) 746-8465. Before faxing any papers please inform the examiner to avoid lost papers. Please note that the faxing of papers must conform with the Notice to Comply published in the Official Gazette, 1096 OG 30 (November 15, 1989). Any inquiry of a general nature or relating to the status of this application should be directed to the group receptionist whose telephone number is (703) 308-0196.



**ETHAN WHISENANT**  
**PRIMARY EXAMINER**